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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/277,172	03/26/1999	TORU MAEDA	35G2368	3148
5514	7590	08/26/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			POKRZYWA, JOSEPH R	
			ART UNIT	PAPER NUMBER
			2622	
DATE MAILED: 08/26/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/277,172	MAEDA, TORU	
	Examiner	Art Unit	
	Joseph R. Pokrzywa	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 June 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 66-68,70-74,89 and 90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 66-68,70-74,89 and 90 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 6/7/04, and has been entered and made of record. Currently, **claims 66-68, 70-74, 89, and 90** are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 66-68, 70-72, 89, and 90** are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams *et al.* (U.S. Patent Number 6,192,045) in view of Merritt *et al.* (U.S. Patent Number 6,421,429, cited in the Office action dated 3/3/04).

Regarding *claim 66*, Williams discloses an image communication method that utilizes a plurality of Internet facsimile modes (see Figs. 2 and 3, and column 1, lines 25 through 54, and column 8, lines 44 through 60, whereby various types of networks are accessible) and a *facsimile mode* (steps 72 ad 85 in Fig. 12, column 9, lines 4 through 9), with the method comprising the steps of detecting an Internet facsimile mode, which a destination apparatus of image data has, from the plurality of Internet facsimile modes during communication in the *facsimile mode*, in accordance with a first procedure signal of the *facsimile mode* from the destination apparatus (steps 74-77 in Fig. 12, column 8, line 44 through column 9, line 20), and transmitting an image

Art Unit: 2622

to the destination apparatus based on the Internet facsimile mode of the destination apparatus detected in the detecting step (step 79 in Fig. 12, column 9, lines 21 through 37).

However, Williams does not expressly disclose if the *facsimile mode* is a G3 facsimile mode.

Merritt discloses an image communication method that utilizes a plurality of Internet facsimile modes (column 5, lines 51 through 58) and a G3 facsimile mode (column 5, lines 58 through 65), with the method comprising the steps of detecting an Internet facsimile mode of a destination apparatus during communication in the G3 facsimile mode, in accordance with a first procedure signal of the G3 facsimile mode (column 5, lines 51 through 65, and column 11, lines 16 through 36), and transmitting an image to the destination apparatus based on the Internet facsimile mode of the destination apparatus detected in the detecting step (column 11, lines 16 through 36).

Williams & Merritt are combinable because they are from the same field of endeavor, being systems that transmit facsimile messages over the Internet.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to consider the facsimile mode of Williams as a G3 facsimile mode taught by Merritt.

The suggestion/motivation for doing so would have been that Williams' system would conform to well known standards in facsimile communication, as recognized by Merritt in column 5, lines 51 through 65.

Therefore, it would have been obvious to combine the teachings of Merritt with the system of Williams to obtain the invention as specified in claim 66.

Regarding **claim 67**, Williams and Merritt disclose the method discussed above in claim 66, and Williams further teaches that the detected Internet facsimile mode of the destination apparatus is stored (see Fig. 2, column 5, line 59 through column 6, line 22), wherein image data is transmitted in accordance with the stored Internet facsimile mode of the destination apparatus (column 8, line 44 through column 9, line 19).

Regarding **claim 68**, Williams and Merritt disclose the method discussed above in claim 67, and Williams further teaches of the step of determining whether or not the communication is a first communication operation in the Internet facsimile mode with the destination apparatus (see Fig. 12), wherein image data is transmitted in the *facsimile mode* in a first communication operation (step 85 in Fig. 12), based on a determination that the communication with the destination apparatus is the first communication operation in the Internet facsimile mode (column 9, lines 4 through 9), and wherein image data is transmitted in the Internet facsimile mode of the destination apparatus (steps 79 and 87 in Fig. 12), based on a determination that the communication with the destination apparatus is not a first communication operation in the Internet facsimile mode (column 9, lines 10 through 45).

However, as previously noted, Williams fails to expressly disclose if the *facsimile mode* is a G3 facsimile mode.

As discussed above in claim 66, Merritt teaches of a method that utilizes a G3 facsimile mode (column 5, lines 51 through 65).

Williams & Merritt are combinable because they are from the same field of endeavor, being systems that transmit facsimile messages over the Internet.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to consider the facsimile mode of Williams as a G3 facsimile mode taught by Merritt.

The suggestion/motivation for doing so would have been that Williams' system would conform to well known standards in facsimile communication, as recognized by Merritt in column 5, lines 51 through 65.

Therefore, it would have been obvious to combine the teachings of Merritt with the system of Williams to obtain the invention as specified in claim 68.

Regarding *claim 70*, Williams and Merritt disclose the method discussed above in claim 66, and Merritt further teaches that the plurality of Internet facsimile modes comprise a simple mode (column 9, line 7 through column 10, line 24, being the desired "less than all the originating image data for certain types of data", and the mode having the "fastest transmission time at a minimum acceptable quality", and column 11, lines 37 through 42), a full mode (column 9, line 41 through column 10, line 43, specifically column 10, lines 25 through 34, with the mode having the sending party transmit an image in any of multiple formats to be received by multiple destinations that can support one or more of the file formats, thereby transmitting full representation of the image data, as opposed to just the minimum amount of image data), and a real time mode (column 5, line 66 through column 6, line 17, and column 9, lines 7 through 65). Continuing, Merritt teaches that when shifting to the Internet facsimile mode, one of a simple mode, a full mode, and a real time mode is selected from among the plurality of Internet facsimile modes possessed by the destination apparatus according to a predetermined priority (column 5, line 66 through column 6, line 36, and column 10, lines 35 through 62), and

Art Unit: 2622

communication in the selected Internet facsimile mode is performed (column 6, line 18 through 36, and column 10, lines 44 through 62).

Williams & Merritt are combinable because they are from the same field of endeavor, being systems that transmit data over the Internet.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the teachings of Merritt in the system of Williams.

The suggestion/motivation for doing so would have been that the system of Williams would be more efficient, as file format capability errors would be reduced since the transmitting device would know the capabilities of the destination apparatus, as recognized by Merritt in column 1, line 27 through column 2, line 18.

Therefore, it would have been obvious to combine Merritt's teachings with the system of Williams to obtain the invention as specified in claim 70.

Regarding *claim 71*, Williams and Merritt disclose the method discussed above in claim 70, and Merritt further teaches that the selection is performed in order of the real time mode, the full mode, and the simple mode (column 5, line 66 through column 6, line 17, column 9, line 66 through column 10, line 62, wherein the subscriber's can set which modes are defaults, and the capabilities they have, which would perform the selection in numerous orders, including real time, full, and simple modes).

Williams & Merritt are combinable because they are from the same field of endeavor, being systems that transmit data over the Internet.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the teachings of Merritt in the system of Williams.

The suggestion/motivation for doing so would have been that the system of Williams would be more efficient, as file format capability errors would be reduced since the transmitting device would know the capabilities of the destination apparatus, as recognized by Merritt in column 1, line 27 through column 2, line 18.

Therefore, it would have been obvious to combine Merritt's teachings with the system of Williams to obtain the invention as specified in claim 71.

Regarding *claim 72*, Williams and Merritt disclose the method discussed above in claim 70, and Merritt further teaches that when the simple mode or the full mode of Internet facsimile has been selected (column 7, lines 23 through 348), an Internet facsimile communication apparatus is caused to transmit an e-mail in which an image file formed in accordance with the selected mode is added (column 7, line 9 through column 8, line 4).

Williams & Merritt are combinable because they are from the same field of endeavor, being systems that transmit data over the Internet.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the teachings of Merritt in the system of Williams.

The suggestion/motivation for doing so would have been that the system of Williams would be more efficient, as file format capability errors would be reduced since the transmitting device would know the capabilities of the destination apparatus, as recognized by Merritt in column 1, line 27 through column 2, line 18.

Therefore, it would have been obvious to combine Merritt's teachings with the system of Williams to obtain the invention as specified in claim 72.

Regarding *claim 89*, Williams discloses an image communication apparatus that utilizes a plurality of Internet facsimile modes (see Figs. 2 and 3, and column 1, lines 25 through 54, and column 8, lines 44 through 60, whereby various types of networks are accessible) and a *facsimile mode* (steps 72 ad 85 in Fig. 12, column 9, lines 4 through 9), with the apparatus comprising a detection unit adapted to detect an Internet facsimile mode, which a destination apparatus of image data has, from the plurality of Internet facsimile modes during communication in the *facsimile mode*, in accordance with a first procedure signal of the *facsimile mode* from the destination apparatus (steps 74-77 in Fig. 12, column 8, line 44 through column 9, line 20), and a transmission unit adapted to transmit an image based on the Internet facsimile mode of the destination apparatus detected by the detecting step (step 79 in Fig. 12, column 9, lines 21 through 37).

However, Williams does not expressly disclose if the *facsimile mode* is a G3 facsimile mode.

Merritt discloses an image communication apparatus that utilizes a plurality of Internet facsimile modes (column 5, lines 51 through 58) and a G3 facsimile mode (column 5, lines 58 through 65), with the apparatus comprising a detection unit adapted to detect an Internet facsimile mode of a destination apparatus during communication in the G3 facsimile mode, in accordance with a first procedure signal of the G3 facsimile mode (column 5, lines 51 through 65, and column 11, lines 16 through 36), and a transmission unit adapted to transmit an image based on the Internet facsimile mode of the destination apparatus detected in the detecting step (column 11, lines 16 through 36).

Art Unit: 2622

Williams & Merritt are combinable because they are from the same field of endeavor, being systems that transmit facsimile messages over the Internet.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to consider the facsimile mode of Williams as a G3 facsimile mode taught by Merritt.

The suggestion/motivation for doing so would have been that Williams' system would conform to well known standards in facsimile communication, as recognized by Merritt in column 5, lines 51 through 65.

Therefore, it would have been obvious to combine the teachings of Merritt with the system of Williams to obtain the invention as specified in claim 89.

Regarding **claim 90**, Williams and Merritt disclose the method discussed above in claim 66, and Williams further teaches of determining an address of the Internet facsimile mode of the destination apparatus in accordance with a second procedure signal of the *facsimile mode* (column 5, line 59 through column 6, line 12, and column 8, lines 44 through 66).

However, as previously noted, Williams fails to expressly disclose if the *facsimile mode* is a G3 facsimile mode.

As discussed above in claim 66, Merritt teaches of a method that utilizes a G3 facsimile mode (column 5, lines 51 through 65).

Williams & Merritt are combinable because they are from the same field of endeavor, being systems that transmit facsimile messages over the Internet.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to consider the facsimile mode of Williams as a G3 facsimile mode taught by Merritt.

The suggestion/motivation for doing so would have been that Williams' system would conform to well known standards in facsimile communication, as recognized by Merritt in column 5, lines 51 through 65.

Therefore, it would have been obvious to combine the teachings of Merritt with the system of Williams to obtain the invention as specified in claim 90.

4. **Claim 73** are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams *et al.* (U.S. Patent Number 6,192,045) in view of Merritt *et al.* (U.S. Patent Number 6,421,429, cited in the Office action dated 3/3/04), and further in view of Okutomi *et al.* (U.S. Patent Number 6,211,972, cited in the Office action dated 3/3/04).

Regarding *claim 73*, Williams and Merritt disclose the method discussed above in claim 72, but fail to expressly disclose if the image file comprises a TIFF file, and wherein an Internet address comprises an e-mail address.

Okutomi discloses a communication method that utilizes a plurality of Internet facsimile modes (column 3, lines 40 through 63) and a facsimile mode (column 3, lines 64 through 67), whereby an image file comprises a TIFF file (column 3, lines 59 through 63, and column 5, lines 31 through 43), and wherein an Internet address comprises an e-mail address (column 3, lines 33 through 63).

Williams, Merritt, & Okutomi are combinable because they are from the same field of endeavor, being systems that transmit facsimile messages over the Internet.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the teachings of Okutomi in the system of Williams and Merritt.

Art Unit: 2622

The suggestion/motivation for doing so would have been that the system of Williams and Merritt would conform to well known standards for communicating facsimile data as an e-mail, as recognized by Okutomi in column 3, lines 33 through 63.

Therefore, it would have been obvious to combine the teachings of Okutomi with the system of Williams and Merritt to obtain the invention as specified in claim 73.

5. **Claim 74** is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams *et al.* (U.S. Patent Number 6,192,045) in view of Merritt *et al.* (U.S. Patent Number 6,421,429, cited in the Office action dated 3/3/04), further in view of Feder (U.S. Patent Number 5,872,845, cited in the Office action dated 3/3/04), and further in view of Kulakowski (WIPO Publication Number WO 97/10668, cited in the Office action dated 3/3/04).

Regarding **claim 74**, Williams and Merritt disclose the method discussed above in claim 70, and Merritt further teaches that the Internet facsimile communication apparatus transmits packets to an Internet address (column 9, lines 31 through 65).

However, Williams and Merritt fail to expressly disclose of when the real time mode has been selected, an Internet facsimile communication apparatus is caused to convert a procedure signal and image data into TCP packets, transmit the TCP packets according to a T30 facsimile procedure, and convert TCP packets received from the communication partner's apparatus into a T30 frame.

Feder discloses an image communication method that utilizes a plurality of Internet facsimile modes (column 5, lines 51 through 66, and column 7, line 55 through column 8, line 67) and a G3 facsimile mode (column 1, line 49 through column 2, line 36, column 6, lines 3

Art Unit: 2622

through 24, and column 7, lines 44 through 54), with the method comprising the steps of detecting an Internet facsimile mode (column 1, lines 49 through 58), which a destination apparatus of image data has, from the plurality of Internet facsimile modes during communication in the G3 facsimile mode (column 1, lines 49 through 58, column 6, lines 3 through 24, and column 7, lines 44 through 54), and transmitting an image to the destination apparatus (see Fig. 8B, "yes" determination of "long distance call", leading to process shown in Fig. 8C, column 8, lines 24 through 67) based on the Internet facsimile mode of the destination apparatus detected in the detecting step (column 9, lines 14 through 32). Further, Feder teaches that when a real time mode has been selected (column 7, lines 64 through 67), an Internet facsimile apparatus is caused to convert a procedure signal and image data into packets (column 8, lines 17 through 67), transmit the obtained packets according to a facsimile procedure (column 9, line 53 through column 10, line 25), and convert packets received from the communication partner's apparatus into a facsimile frame (column 9, line 65 through column 10, line 25).

Williams, Merritt, & Feder are combinable because they are from the same field of endeavor, being systems that transmit facsimile messages over the Internet.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the teachings of Feder in the system of Williams and Merritt.

The suggestion/motivation for doing so would have been that Williams and Merritt's system would conform to well known standards for communicating facsimile data as an e-mail, as recognized by Feder in column 8, lines 37 through 67.

Therefore, it would have been obvious to combine the teachings of Feder with the system of Williams and Merritt.

Continuing, Feder also fails to expressly disclose of converting a T30 frame into TCP packets, and converting TCP packets into a T30 frame, and subsequently, transmitting the obtained TCP packets according to a T30 facsimile procedure, and converting TCP packets received from the communication partner's apparatus into a T30 frame.

Kulakowski discloses a communication method having an Internet facsimile communication function comprises transmitting TCP packets to an Internet address (page 13, lines 11 through 36, and page 14, lines 20 through 36), receiving TCP packets (page 20, lines 24 through 30), converting a T30 frame into TCP packets (page 14, lines 20 through 36, and page 16, line 28 through page 17, line 19), and converting TCP packets into a T30 frame (page 20, line 27 through page 21, line 7), and wherein the Internet facsimile communication apparatus is caused to convert a procedure signal and image data into TCP packets, transmit the obtained TCP packets according to a T30 facsimile procedure, and convert TCP packets received from the communication partner's apparatus into a T30 frame (see Figs. 5, 7, and 8).

Williams, Merritt, Feder, & Kulakowski are combinable because they are from the same field of endeavor, being systems that transmit facsimile messages over the Internet.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the teachings of Kulakowski in the system of Williams, Merritt, and Feder.

The suggestion/motivation for doing so would have been that Williams, Merritt, and Feder's system would conform to well known standards for communicating facsimile data as an e-mail, as recognized by Kulakowski in page 20, line 24 through page 21, line 7.

Therefore, it would have been obvious to combine the teachings of Kulakowski and Feder with the system of Williams and Merritt to obtain the invention as specified in claim 74.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

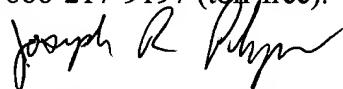
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph R. Pokrzywa
Examiner
Art Unit 2622

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